

REMARKS/ARGUMENTS

Favorable reconsideration of this Application, as presently amended and in light of the following discussion, is respectfully requested.

This Amendment is in response to the Office Action mailed on December 14, 2004. Claims 1-4, 6-14, and 19-25 are pending in the Application and stand rejected. Claims 24 and 25 are amended by the present Amendment.

Summarizing the outstanding Office Action, Claims 24 and 25 were rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claims 1-4, 6-9, 11, 13, 14, and 19-25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Obrist et al. (U.S. Patent No. 4,111,322, hereinafter "Obrist") in view of Kamata et al. (U.S. Patent No. 5,431,697, hereinafter "Kamata"). Claims 10 and 12 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Obrist in view of Kamata and further in view of Ohmi et al. (U.S. Patent No. 5,769,255, hereinafter "Ohmi").

In response to the rejection under 35 U.S.C. §112, second paragraph, Applicants have amended Claims 24 and 25, correcting the indicated indefiniteness, and respectfully request withdrawal of that rejection. It is believed that all pending claims are definite and no further rejection on that basis is anticipated. If, however, the Examiner disagrees, the Examiner is invited to telephone the undersigned who will be happy to work with the Examiner in a joint effort to derive mutually acceptable language.

As to the rejection of Claims 1-4, 6-9, 11, 13, 14, and 19-25 in view of the combination of Obrist and Kamata, Applicants respectfully submit these references, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in Claims 1-4, 6-9, 11, 13, 14, and 19-25. This is so because there is no suggestion or motivation, either in the references themselves or in the knowledge generally

available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings.¹

Obrist discloses a synthetic plastic cap for bottles formed, on its outer lid surface, with an elevated portion designed to prevent contact with markings on the lid by articles placed on top of the bottle.²

The Office acknowledges that Obrist fails to disclose forming a cap of plastic with admixed thermochromic materials and cites Kamata to remedy that deficiency. The outstanding Office Action further states that the proposed modification would have been obvious for "the benefit of providing a sophisticated, highly fashionable appearance" to the cap of Obrist. The record, however, fails to provide the required evidence of a motivation for a person of ordinary skill in the art to perform such modification.

While Kamata may provide a reason for using the variable color composition for synthetic resin articles, it fails to suggest why a person of ordinary skill in the art would be motivated to use such compositions in the synthetic plastic cap of Obrist, which has an elevated portion for the prevention of contact with markings on the lid by articles placed on top of the cap. Applicants fail to recognize the need for Obrist's cap to be "sophisticated, [and of a] highly fashionable appearance." Obrist's invention focuses on a modified cap shape to allow stacking of bottles on top of each other without damaging markings found thereon. As such, Applicants fail to recognize how one of ordinary skill in the art, exposed to the disclosures of Obrist and Kamata, would be motivated to make a cap shaped to prevent damage to top markings change color with temperature.

¹ See MPEP 2143.01 stating "[o]bviousness can only be established by combining or modifying the teaching of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art," (citations omitted). See also MPEP 2144.08 III stating that "[e]xplicit findings on motivation or suggestion to select the claimed invention should also be articulated in order to support a 35 U.S.C. 103 ground of rejection. . . . Conclusory statements of similarity or motivation, without any articulated rational or evidentiary support, do not constitute sufficient factual findings."

² Obrist, abstract.

Similarly, Obrist states that its structure already achieves the goal of allowing the bottles to be stacked without damaging markings thereon and is silent about admixed thermochromic materials. Obrist does not suggest that further improvement is desired or that its caps should be sophisticated and highly fashionable in appearance such as the articles suggested by Kamata, which incidentally, as implicitly acknowledged by the Office, does not suggest making articles as disclosed by Obrist or as recited in the instant inventions as recited.

Therefore, Obrist and Kamata do not provide the motivation to perform the proposed modification of the Obrist cap. In other words, an attempt to bring in the isolated teaching of Kamata's variable color patterning composition for synthetic resin articles into the Obrist device would amount to improperly picking and choosing features from different references without regard to the teachings of the references as a whole.³ While the required evidence of motivation to combine need not come from the applied references themselves, the evidence must come from *somewhere* within the record. In this case, there is nothing in the record supporting the Office Action's proposed modification of the Obrist patent.

The outstanding Office Action seems to suggest that simply because two different things may be known (i.e., the plastic cap of Obrist and the thermochromic composition of Kamata), a motivation exists to combine the two irrespective of what the references themselves teach. Such a premise has been clearly found unpersuasive as a motivation to combine references in § 103 rejections. See, for example, MPEP § 2144.04.⁴

³ See In re Ehrreich 590 F.2d 902, 200 USPQ 504 (CCPA, 1979) (stating that patentability must be addressed "in terms of what would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the sum of all the relevant teachings in the art, not in view of first one and then another of the isolated teachings in the art," and that one "must consider the entirety of the disclosure made by the references, and avoid combining them indiscriminately.")

⁴ In In re Dembiczak, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), the claims of a utility application, drawn to a generally round, orange plastic trash bag with a jack-o-lantern face, were rejected under 35 U.S.C. 103. However, the court reversed the rejection for lack of motivation to combine conventional trash bags with a reference showing a jack-o-lantern face on an orange paper bag stuffed with newspapers.

In rejecting a claim under 35 U.S.C. § 103(a), the USPTO must support its rejection by "substantial evidence" within the record,⁵ and by "clear and particular" evidence⁶ of a suggestion, teaching, or motivation to combine the teachings of different references. As discussed above, there is no substantial evidence, nor clear and particular evidence, within the record of motivation for modifying the cap of Obrist by incorporating the color changing composition of Kamata. Without such motivation and absent improper hindsight reconstruction,⁷ a person of ordinary skill in the art would not be motivated to perform the proposed modification, and Claims 1-4, 6-9, 11, 13, 14, and 19-25 are believed to be non-obvious and patentable over the applied references.

In addition, Applicants respectfully submit that Claims 24 and 25 patently distinguish from Obrist and Kamata because neither one teach or disclose a thermochromic ink.

Therefore, Obrist and Kamata, neither individually nor in any combination, make obvious the invention recited in Claims 1-4, 6-9, 11, 13, 14, and 19-25. For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 1-4, 6-9, 11, 13, 14, and 19-25 under 35 U.S.C. § 103(a) in view of Obrist and Kamata.

As to the rejection of Claims 10 and 12 in view of the combination of Obrist, Kamata, and Ohmi, Applicants respectfully submit these references, neither individually nor in any combination, support a *prima facie* case of obviousness of the invention recited in Claim 1. This is so because there is no suggestion or motivation, either in the references themselves or

⁵ In re Gartside, 203 F3d 1305, 53 USPQ2d 1769 (Fed. Cir. 2000) (holding that, consistent with the Administrative Procedure Act at 5 USC 706(e), the CAFC reviews the Board's decisions based on factfindings, such as 35 U.S.C. § 103(a) rejections, using the 'substantial evidence' standard because these decisions are confined to the factual record compiled by the Board.)

⁶ In re Dembiczak, 175 F3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, although 'the suggestion more often comes from the teachings of the pertinent references.' The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular.") (emphasis added).

⁷ See MPEP 2141, stating, as one of the tenets of patent law applying to 35 USC 103, that "[t]he references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention."

in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Claims 10 and 12 depend from Claim 1.

The lack of motivation to combine Obrist and Kamata has already been explained. Ohmi, being cited only for teaching a sealing liner insert, does not remedy the lack of motivation to combine Obrist and Kamata. Therefore, there is no motivation to combine Obrist, Kamata, and Ohmi in support of a finding of obviousness in the invention of Claim 1. Claims 10 and 12 patently distinguish from the combination of Obrist, Kamata, and Ohmi at least because of their dependency from Claim 1.

In addition, Applicants respectfully submit that Claim 10 patently distinguish from the combination of Obrist, Kamata, and Ohmi. Claim 10 recites a two-piece cap, as for example, but not as a limitation, a pop-up cap as illustrated in Applicants' figures. None of Obrist, Kamata, or Ohmi discloses such a two-piece cap.

Therefore, Obrist, Kamata, and Ohmi, neither individually nor in any combination, make obvious the invention recited in Claims 10 and 12. For the foregoing remarks, Applicants respectfully request withdrawal of the rejection of Claims 10 and 12 under 35 U.S.C. § 103(a) in view of the combination of Obrist, Kamata, and Ohmi.

The present amendment is submitted in accordance with the provisions of 37 C.F.R. §1.116, which after a Final Rejection permits entry of amendments placing the claims in condition for allowance or in better form for consideration on appeal.⁸ As the present amendment is believed to overcome the outstanding rejections under 35 U.S.C. §§ 112 and 103, the present amendment places the application either in condition for allowance or in better form for consideration on appeal. In addition, the present amendment is not believed to raise new issues since the changes to Claims 24 and 25 simply correct an antecedent issue, thus being of a minor nature.

⁸ See, for example, MPEP § 714.12.

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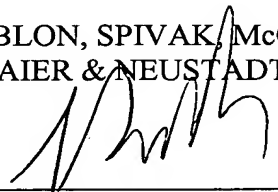
It is therefore respectfully requested that 37 C.F.R. § 1.116 be liberally construed, and that the present amendment be entered.

Consequently, in view of the present amendment, no further issues are believed to be outstanding in the present application, and the present application is believed to be in condition for formal Allowance. A Notice of Allowance for Claims 1-4, 6-14, and 19-25 is earnestly solicited.

Should the Examiner deem that any further action is necessary to place this application in even better form for allowance, the Examiner is encouraged to contact Applicants' undersigned representatives at the below listed telephone number.

Respectfully submitted,

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